

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) NAI1P312/01.048.02	
I hereby certify that this correspondence is being e-filed with the USPTO on <u>April 30, 2007</u> Signature <u>/Erica L. Farlow/</u> Typed or printed name <u>Erica L. Farlow</u>	Application Number <u>09/916,607</u>	Filed <u>07/26/2001</u>	
	First Named Inventor <u>Rodney D. Cambridge</u>		
	Art Unit <u>2137</u>	Examiner <u>Pyzocha, M.</u>	
	Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.		
I am the			
<input type="checkbox"/> applicant/inventor.		<u>/KEVINZILKA/</u>	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Signature <u>Kevin J. Zilka</u>	
<input checked="" type="checkbox"/> attorney or agent of record. <u>41,429</u> Registration number _____		Typed or printed name <u>(408) 971-2573</u>	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Telephone number <u>April 30, 2007</u>	
		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS

The Examiner has rejected Claims 1, 3, 5-6, 10, 15-16, 19-20, 25-26, and 34-38 under 35 U.S.C. 103(a) as being unpatentable over Doub (U.S. Patent No. 6,594,762), in view of Lunsford et al. (U.S. Patent No. 6,614,350), and in further view of Logan (U.S. Patent No. 6,631,271).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

With respect to the first element of the *prima facie* case of obviousness and, in particular, the obviousness of combining the aforementioned references, the Examiner has argued that it would have been obvious to combine Doub with Lunsford "to include the Bluetooth alerting of Lunsford et al. in the system of Doub," and that the "[m]otivation to do so would have been to deter the theft and prevent inadvertent abandonment of various portable devices (see Lunsford et al. Col. 2, lines 37-47)." To the contrary, applicant respectfully asserts that it would not have been obvious to combine the teachings of the Doub and Lunsford references, especially in view of the vast evidence to the contrary.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Thus, the claimed combination cannot change the principle of operation of the

primary reference or render the reference inoperable for its intended purpose. See MPEP § 2143.01.

In particular, in the Office Action dated 08/18/06, the Examiner admitted that “Doub clearly and expressly teaches a handheld security system which is maintained between ‘an electronic device and a remote device’ (abstract line 1).” The Examiner further noted that “[t]he entire disclosure relates to a system in which one device is controlled by one control unit (e.g. Col 1, line 46 to Col 2, line 16; Fig 1).” Additionally, the Examiner admitted that “[n]ot only is there no disclosure that a device is registered with more than one control unit, such teaching would appear to be logically inconsistent with Doub as Doub’s control unit would be inoperable to control the device if the device were...registered with other control units seeking to control the device” (See page 10 of the Office Action dated 08/18/06-emphasis added).

However, applicant respectfully asserts that Lunsford teaches “a method and system for effecting a security system upon multiple devices” and that “[t]he invention provides for multiple devices to respond as authorized members of a security web such that each device acts as a co-monitoring device within the web” (see Col. 2, lines 37-41; and Figures 1-4 – emphasis added). Lunsford further teaches that “[e]ach device periodically polls for the presence of all the other devices in the piconet and if the signal from any device is not detected by any other device in the piconet then all devices sound an alarm” (Col. 8, lines 42-45 – emphasis added). Thus, because Lunsford clearly teaches multiple devices where each device polls all other devices, the devices in Lunsford are clearly registered with other devices.

Therefore, since Doub discloses a device that is only registered with a single control unit, and the control unit of Doub would be inoperable to control the device if the device were registered to more than one control unit, as admitted by the Examiner, it is clear that modifying the device of Doub according to the system of Lunsford, in which a device is registered with multiple other devices, would render the invention of Doub unsatisfactory for its intended purpose. To emphasize, because the Examiner has

admitted that “Doub’s control unit would be inoperable to control the device if the device were...registered with other control units seeking to control the device” (emphasis added), and Lunsford teaches multiple devices polling other devices, the Examiner’s proposed combination of the Doub and Lunsford reference is improper under *In re Gordon*.

Additionally, applicant respectfully asserts that the third element of the *prima facie* case of obviousness has also not been met by the prior art excerpts relied on by the Examiner. For example, with respect to the independent claims, the Examiner has relied on Col. 7, lines 9-15; and Col. 8 lines 38-49 from Lunsford to make a prior art showing of applicant’s claimed technique “wherein the control unit includes a control unit display, the control unit display being configured to display information associated with the device when it is determined that the device is not within the range of communications of the control unit” (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that Col. 7, lines 9-15 from Lunsford, as relied on by the Examiner, merely teaches that “upon the determination of a non-authorized loss of proximity, an event is initiated upon at least one device in the security web” and that “[t]he event initiated may vary widely with examples being the activation of audio and visual alarms, the activation and deactivation of user pre-determined devices, and the transmission of communications to a device outside of the security web” (Col. 7, lines 9-15 – emphasis added). However, only generally disclosing that visual alarms may be initiated upon the loss of proximity of a device, as in Lunsford, in no way specifically suggests that “the control unit includes a control unit display, the control unit display being configured to display information associated with the device when it is determined that the device is not within the range of communications of the control unit” (see at least substantially the same subject matter in each of the independent claims-emphasis added), as claimed by applicant. Simply indicating that a visual alarm may be initiated, as in Lunsford, simply fails to meet “display[ing] information associated with the device” via

“a control unit display” (see at least substantially the same subject matter in each of the independent claims-emphasis added), as claimed by applicant.

Additionally, Col. 8, lines 45-49 from Lunsford, as relied on by the Examiner, simply teaches that “any device which loses contact with all other devices of the piconet displays the owners name, address, and telephone number and then locks itself from further use until such time as a password is entered into the device” (emphasis added). However, displaying the owner’s name, address, and telephone number on the device which has lost contact with all other devices, as in Lunsford, in no way suggests that “the control unit includes a control unit display, the control unit display being configured to display information associated with the device when it is determined that the device is not within the range of communications of the control unit” (see at least substantially the same subject matter in each of the independent claims-emphasis added), as claimed by applicant. Clearly, displaying the owner’s information on the device which has lost contact, as in Lunsford, fails to suggest “display[ing] information associated with the device” via “a control unit display” (see at least substantially the same subject matter in each of the independent claims-emphasis added), as claimed by applicant.

In addition, with respect to the independent claims, the Examiner has again relied on Col. 7, lines 9-15 and Col. 8, lines 38-49 in Lunsford to make a prior art showing of applicant’s claimed technique “wherein the device includes a device display, the device display being configured to display information associated with the control unit when it is determined that the device is not within the range of communications of the control unit” (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that, as argued above, the excerpts relied on by the Examiner only generally disclose that visual alarms may be initiated upon the loss of proximity of a device and that the owner’s name, address, and telephone number are displayed on the device which has lost contact with all other devices. Clearly, only generally disclosing visual alarms, along with displaying information on the device which has lost contact with all other devices, as in Lunsford, fails to meet applicant’s claimed

technique “wherein the device includes a device display, the device display being configured to display information associated with the control unit when it is determined that the device is not within the range of communications of the control unit” (see at least substantially the same subject matter in each of the independent claims-emphasis added), as claimed.

Further, with respect to the independent claims, the Examiner has relied on Col. 2, lines 30-63; and Col. 6, lines 41-53 from Logan to make a prior art showing of applicant’s claimed technique “wherein the device is configured to periodically send the identifying signal utilizing a period of time which is configured based on movements of an owner” (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that the excerpts relied on by the Examiner merely teach that “Blue Tooth chips could be integrated into a small device (here called a ‘badge’) whose prime function is to indicate position and which can be...placed on or near stationary devices, such as the Palm docking station, or the cell phone recharger, with which Bluetooth devices or things bearing other Bluetooth badges could link to at times” (Col. 6, lines 47-53 - emphasis added). In addition, the excerpts relied on by the Examiner teach that “[a]lthough the Bluetooth chips in these devices may be primarily intended for different functions, they can play a useful role in the position monitoring and notification system contemplated by the present invention” (Col. 2, lines 59-62 – emphasis added). However, using Blue Tooth chips to indicate position and for position monitoring, as in Logan, fails to even suggest “a period of time which is configured based on movements of an owner,” let alone that “the device is configured to periodically send the identifying signal utilizing a period of time which is configured based on movements of an owner” (emphasis added), as claimed by applicant.